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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,622	10/09/2001	Brian Samuel Beaman	YO995-023US4	5193

7590

02/04/2003

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EXAMINER

NGUYEN, VINH P

ART UNIT

PAPER NUMBER

2829

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,622

Applicant(s)

BEAMAN ET AL.

Examiner

VINH P NGUYEN

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2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 16-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. Claims 16-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 5.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of "decoupling capacitor" as recited in claim 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. Claims 4-5,8-9 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, "said protuberance" has not been recited previously, therefore this term is indefinite. Furthermore, it is unclear what "said protuberance" represents. Is it shown in any of drawings? In claim 5, it is unclear what "a decoupling capacitor" represents. Is it shown in any of drawings? In claim 8, "said second contact locations" has no antecedent basis. Should this claim depend on claim 7 instead of claim 1. In claim 9, it is unclear how the electrical conductor

patterns are interrelated and associated with, In claim 15, it appears that the limitation of "said openings in said layers are adapted to receive said contact location on said workpiece having ball shape" is inaccurate. It appears that the openings are used to receive contact locations on the workpiece

having the ball shape. Furthermore, it appears that "adapted to" is improper claim language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2,6-8,11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motooka et al (Pat # 5,831,441).

As to claim 1, Motooka et al disclose in figure 7 an apparatus for testing semiconductor device (22) with a plurality of conductive contact locations (27) having a substrate (20) with first and second surface, a plurality of probe tips (24) disposed on a plurality of first contact locations on the first surface of the substrate (20). It is noted that each of the probe has an elongated electrically conductive member (24) projected from an enlarged base disposed on the first contact location. According to Motooka et al, the workpiece is brought into contact with the probes, it appears that Motooka et al has moving means. However, it would have been old and well known in the art that the moving means could be used to move the substrate into contact

with the workpiece since this is an alternative way to have the probes in contact with the workpiece. As to claim 2, it appears that the probe (24) is made of Gold (Au). As to claim 6, it appears that the elongated member has a flattened end. As to claims 7-8, it appears that the second surface (bottom surface) of the substrate (20) has second contact locations in which elongated electrical conductors (25) are attached thereto. As to claim 10, Motooka et al teach that it would have been well known in the art to provide a sheet of material (125) with a plurality of openings and this sheet is disposed over plurality of probe tips (124). As to claim 11, it appears that the conductive member (24) has a first end disposed in contact with the enlarged base and the second end disposed in contact with an enlarged tip. As to claims 12-13, it appears that the layer of material is disposed between the base and the tip and its openings are aligned with the probe tips. As to claim 14, it appears that the openings in the layer are larger than the probe tip.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khandros (Pat # 5,476,211).


As to claim 1, Khandros disclose in figure 8 a substrate (10) with first and second surfaces, a plurality of probes (55,90) disposed on first electrical contact locations. It appears that the device of Khandros as shown in figure 8 is used for testing purpose. However, Khandros does not mention about the moving means for moving the substrate toward a workpiece so that the probes are in contact with the contact locations on the workpiece. It would have been old and well known in the art that the moving means could be used to move the substrate into

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contact with the workpiece since this is an alternative way to have the probes in contact with the workpiece. As to claims 2-3, it appears that the wires are made of gold and this wire is also coated with Titanium (see column 10, lines 17-26 and column 17, lines 47-52).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINH P. NGUYEN whose telephone number is (703) 305-4914.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4900.


VINH P. NGUYEN
PRIMARY EXAMINER
ART UNIT 2829
01/23/2003